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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,769	06/28/2001	Yoshiki Kawaoka	3562-0118P	3442
2292	7590	03/24/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ARAQUE JR, GERARDO	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,769

Applicant(s)

KAWAOKA ET AL.

Examiner

Gerardo Araque Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2001 June 28.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to because in Figure 1 Item 150 the term "PRINTINT" is misspelled.
3. The drawings are objected to because in Figure 1 Item 40 the term "DELIVERY-MEDIUM RECORDING APPARATUS" should be read as "DELIVERY-MEDIUM RECORDING UNIT" in order to coincide with what is claimed in claim 1.
4. The drawings are objected to because "IMAGE RECEIVING UNIT" should read as "RECEIVING UNIT" in order to coincide with what is being claimed in claim 1.
5. The drawings are objected to because the examiner is not sure if "CONVERTED IMAGE KEEPING UNIT" is the "another receiving unit" that is being claimed in claim 2.
6. The drawings are objected to because the examiner would appreciate if the steps required to carry out the instructions for the program that is claimed in claims 18 – 20 were shown.
7. The drawings are objected to because the examiner would appreciate if the steps required for what is claimed in claims 21 – 27 were shown.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A SYSTEM AND METHOD FOR IMAGE COLLECTION, PRODUCTION, AND DELIVERY

9. The disclosure is objected to because of the following informalities: On Page 9 Line 5 the term "CD-R, MO" is misspelled and should be read as "CD-ROM."

10. On **Page 11 Lines 8 – 11**, careful rewording of the paragraph is needed. The examiner understands the disclosure as a phone number or e-mail address and the date of each image taken and stored in the digital camera are transmitted along with the image itself.

11. On **Page 14 Lines 13 – 16**, careful rewording is needed. The applicant does not specifically disclose what is advantageous to the management of the images.

Appropriate correction is required.

Claim Objections

12. **Claims 1 – 17** are objected to because of the following informalities: The examiner understands that the delivery-medium producing apparatus is actually a system and suggests changing “A delivery-medium producing apparatus” to “A delivery-medium producing system,” which can be found on the first lines of the previously mentioned claims.

13. **Claim 9 last line**, the examiner suggests changing “number” to “quantity.”

14. **Claim 22 3rd line** of the claim, the examiner suggests changing “said capturing unit” to “said capturing device.”

15. **Claim 30 last line**, the examiner would like to inform applicant that “said keeping” should be changed to “said image keeping apparatus.”

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. **Claims 1 – 2, 4 – 14, and 30** are rejected under 35 U.S.C. 102(b) as being anticipated by Fredlund et al. (US Patent 5,666,215).

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18. In regards to **claim 1**, Fredlund discloses a photofinisher that receives film from a customer, scans the film, and stores the scanned images (Column 2 Lines 28 – 31).

Moreover, the images files are stored in a storage device, which were scanned from the photofinisher (Column 4 Lines 34 – 36). Furthermore, Fredlund also discloses a CD-writer for producing Photo CD's (Column 7 Lines 26 – 27).

19. In regards to **claim 2**, Fredlund discloses that the processed film is also scanned into a scanner in order to convert the negative film into digital images (Column 3 Lines 29 – 31) and is attached with a customer identification number (Column 3 Lines 34 – 36). Once the images are converted they can be later recorded onto a Photo CD, as was previously discussed.

20. In regards to **claim 4**, Fredlund discloses that once the customer is done with placing an order (Column 6 Lines 30 – 36) the images can then be recorded onto a CD with the use of a CD-writer (Column 8 Lines 56 – 63).

21. In regards to **claim 5**, Fredlund discloses a computer data entry means that allows a user to input information related to their images (Column 5 Lines 44 – 51).

This information can then be recorded onto a recording media if the user chooses to.

22. In regards to **claim 6**, the use of using user ID's in order to access information, especially for online shopping, is well known and common practice in the art.

23. In regards to **claim 7**, the examiner understands that the date and the place are just more information that the user can input into the database that further identifies the images. When the user accesses the database to have select the images they would want recorded they can do so based on the information that was provided. Moreover, it

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is well known that digital cameras use such information in order to organize the images on its storage medium and that cameras inherently have some type of GPS unit imbedded in them so that phone companies can track where phone calls are being made and determine if the phone is in a roaming area. Therefore, when the images are transmitted to their location through the cellular phone a tag, such as the date and location, must be sent with it so that the phone company can later charge the user for the extra service.

24. In regards to **claim 8**, Fredlund discloses a system and method for facilitating ordering and re-ordering of prints from negatives (Column 2 Lines 45 – 27). Moreover, Fredlund discloses a computer that controls an image-capable printer for paper prints (Column 7 Lines 18 – 26).

25. In regards to **claim 9**, Fredlund discloses that once the customer chooses which images to be re-ordered, the customer is presented with services related to the selected image, such as the quantity and the size (Column 2 Lines 47 – 57 Column 3 Lines 52 – 63).

26. In regard to **claims 10 and 11**, Fredlund discloses a mass storage device that stores the, "...digital image along with a customer order number and a unique customer identification number (Column 3 Lines 33 – 36)." The customer is then able to use the identification number given to them to access the images they would like to be printed (Column 4 Lines 46 – 50).

27. In regard to **claims 12 – 14**, Fredlund disclosure of a photo production and delivery system that allows customers to submit images to a storage device and assign

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the customers with an identification number is discussed above. The identification number allows them to access the storage device and select the images they would like printed or recorded on a medium. In the case that the customer would like the images to be recorded on a medium, such as a CD, a CD-writer that is integrated to a computer system would be used. Moreover, the optical disc would have the identification number and image recorded on it (Column 3 Lines 32 – 36).

28. In regards to **claim 30**, Fredlund discloses that the processed film is also scanned into a scanner in order to convert the negative film into digital images (Column 3 Lines 29 – 31) and is attached with a customer identification number (Column 3 Lines 34 – 36). Fredlund also discloses a mass storage device that stores the, "...digital image along with a customer order number and a unique customer identification number (Column 3 Lines 33 – 36)." The customer is then able to use the identification number given to them to access the images they would like to be printed (Column 4 Lines 46 – 50).

29. **Claims 15 – 17** are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al. (US Patent 6,760,128 B2).

30. In regard to **claims 15 – 16**, Jackson discloses a payment schedule service that monitors how long an image has been stored in a storage device. After a predetermined time has passed, the system will increase the cost to store the image (Column 3 Lines 9 – 17). Moreover, Jackson also discloses that the storage time is dependant on how long the user would like to store the images in order to properly compensate a service provider for long-time storage of a user's images (Column 1

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Lines 60 – 62). It is inherent, that this service must have a notification system in order to alert the user that a predetermined time has gone by so that the user knows that the cost to store the images will go up after the initial predetermined time has expired (Column 3 Lines 9 – 27).

31. In regards to **claim 17**, Jackson discloses a payment service in which the customer chooses their mode of payment, such as cash, check, or a charge/debit card (Column 11 Lines 61 – 64). Moreover, after the user specifies the payment method the user can then give the account needed to make the necessary payments and have the money deducted for the services (Column 5 Lines 31 – 36).

32. **Claims 18 – 22, 25 – 27, and 30** are rejected under 35 U.S.C. 102(b) as being anticipated by Allen et al. (US Patent 5,737,491).

33. In regard to **claims 18 and 19**, Allen discloses a camera that is connected wirelessly to a cellular phone (Column 3 Lines 5 – 9) for the transmission of images to a server. In Table 1 a list of commands are disclosed, such as the “Send Prints (address)” command that will send the images to a designated address or number through the cellular phone (Column 2 Lines 1 – 5, Claim 7). It is inherent that these operations must be carried out with the use of a program and a connection-detecting module.

34. In regards to **claim 20**, the examiner understands the monitoring module’s function is to just keep track of how many pictures have been taken and that the predetermined number is a number chosen by the user of the camera. It is, therefore, obvious that digital cameras have features that monitor details concerning the camera

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and the amount of images that have been taken. When the camera can no longer hold any more images because it has reached a predetermined number, which happens to be the maximum number of images that the camera can hold, then the user can transmit the images in a manner that has already been previously discussed above.

The examiner would also like to note that the camera does not have to be full in order to send the images. If the user of the camera would like to transmit the images when some predetermined amount chosen by the user of the camera then user can do so.

35. In regards to **claim 21**, Allen discloses that digital images taken by a photographer with a digital camera are transmitted wirelessly to a cellular phone, which will then be received by an image fulfillment server (Column 1 Lines 60 – 65, Column 3 Lines 5 – 8). These operations are carried out with a microprocessor found within the digital camera (Figure 1).

36. In regards to **claim 22**, Allen discloses a voice recognition program that allows a user to instruct the camera to send images to an external apparatus (Allen Column 3 Lines 49 – 52).

37. In regard to **claim 25**, Allen discloses that the camera "...includes an interface, such as a SCSI port, for connecting to an external input device 27 such as a keyboard or LCD touch screen. The external input device 27 may be used to enter information such as text annotation, electronic addresses of file names that are to be associated with photographer's utterances (Column 2 Lines 63 – 67, Column 3 Line 1)." After the photographer takes the picture, a verbal command can be given to transmit the images (Column 3 Lines 49 – 52).

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38. In regards to **claim 26**, it is well-known in the art that a digital camera has a display to view stored images and select which images the user would like to view, one such example is Kodaks' DC4800 Digital Camera

(<http://www.pcstats.com/articleview.cfm?articleID=593>,

<http://web.archive.org/web/20000815073948/www.kodak.com/US/en/digital/cameras/D CSGateway.jhtml>)

39. In regards to **claim 27**, Allen discloses a transceiver that is part of the digital camera (Figure 1, Column 2 Lines 48 – 51).

Claim Rejections - 35 USC § 103

40. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

41. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (US Patent 5,666,215) in view of Komatsu et al. (US Patent 4,817,050).

42. In regards to **claim 3**, Fredlund is discussed above, but fails to teach a system that is able to record images at predetermined intervals. However, Komatsu does teach a database system that contains a counter that transfers data from one filing system to another after a predetermined period of time lapses (Komatsu Column 7 Lines 59 – 63). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Komatsu to modify Fredlund to include a

database with a counter to record images at predetermined intervals, such as after a predetermined period of time has lapsed.

43. **Claims 23 - 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (US Patent 5,737,491) in view of Komatsu et al. (US Patent 4,817,050).

44. In regards to **claim 23 and claim 24**, the examiner notes that the fact that the images are transmitted after a predetermined time or quantity has been reached does not affect the actual function of how the images are transmitted, i.e. time and quantity are the same in that they are both measurements that both will carry out the same function of triggering the transmission of the images. With that said, Allen discloses a voice recognition program stored in a camera, which stores images, that is connected wirelessly to a cellular phone, which transmits the images to an external apparatus, such as an image fulfillment server (Allen Column 1 Lines 60 – 65, Column 3 Lines 5 – 8, Column 3 Lines 49 - 52). Allen fails to teach that the transmission of these images is transmitted after a predetermined number or time has been reached. However, Komatsu does teach a database system that contains a counter that transfers data from one filing system to another after a predetermined period of time lapses (Komatsu Column 7 Lines 59 – 63). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Komatsu to modify Allen to include a database with a counter to transmit images from the camera to the image fulfillment server after a period of time has lapsed.

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45. **Claims 28 – 29 and 31 – 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (US Patent 5,666,215) in view of Allen et al. (US Patent 5,737,491) and in further view of Jackson et al. (US Patent 6,760,128 B2).

46.

47. In regards to **claim 28**, Fredlund discloses a photofinisher that receives film from a customer, scans the film, and stores the scanned images (Column 2 Lines 28 – 31), which can be found at a photo store, drugstore, or supermarket (Column 3 Lines 25 – 27). Moreover, the images files are stored in a storage device, which were scanned from the photofinisher (Column 4 Lines 34 – 36). Furthermore, Fredlund also discloses a CD-writer for producing Photo CD's (Column 7 Lines 26 – 27). When the order is completed, the images can be returned to the customer by mail or picked up by the customer at the location where there were dropped off (Column 3 Lines 39 – 42).

48. In regards to **claim 29**, Fredlund is discussed above, but fails to teach a method of transmitting digital images via a phone. However, Allen teaches a method of transmitting images taken by a digital camera that is wirelessly connected to a cellular phone to a specified location (Column 3 Lines 5 – 9, Column 2 Lines 1 – 5, Claim 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Allen to modify Fredlund's method to include a method of transmitting images to a specified location via a cellular phone.

49. In regards to **claim 31 - 34**, it is well known in the art that a customer must present a method of payment at the time that a specific service is completed whether it would be cash or credit. In regards to be charged through a phone company, it is well

known in the art that phone companies will charge their customers for any extra services on top of their customers' regularly monthly charges. With that said, Fredlund and Allen are discussed above, but fail to teach a method of payment. However, Jackson does teach a payment service in which the customer chooses their mode of payment, such as cash, check, or a charge/debit card (Column 11 Lines 61 – 64). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Jackson to modify Fredlund and Allen to include a payment service for the delivery of the submitted images.

Conclusion

50. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Jackson et al. (Pub. No. US 2002/0105658 A1) – Jackson discloses a method of selecting images stored by a user in a memory location of a service provider and ordering services using a designated date for a payment schedule.
2. Sheridan (US Patent 5,760,917) - Sheridan discloses an image distribution method and system.
3. Dellert et al. (US Patent 5,760,916) – Dellert discloses an image handling system and method.
4. Dellert et al. (US Patent 5,926,288) – Dellert discloses an image handling system and method using mutually remote processor-scanner stations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is

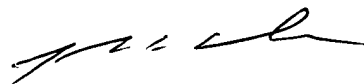
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(571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GA
3-15-2006



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